



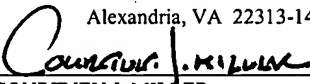
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COURTNEY J. MILLER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|-------------------------------------|---|----------------------------------|
| In re Application of: |) | |
| |) | |
| Edward McCoy |) | Group Art Unit: 3673 |
| |) | |
| Application No.: 10/775,519 |) | Examiner: Gay Spahn |
| |) | |
| Filed: February 10, 2004 |) | Attorney Docket No.: 18525/04071 |
| |) | |
| For: System and Method for Draining |) | |
| Soil Profiles |) | |

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RESPONSE

This paper is responsive to the Office Action mailed on May 19, 2005 which set a one-month shortened statutory period for response. This Response is being filed on July 19, 2005, and a Petition for a One-Month Extension of Time and associated fee is being filed contemporaneously herewith. The Commissioner is hereby authorized to charge any and all required fees to Deposit Account No. **03-0172** (Calfee, Halter & Griswold LLP).

Restriction Requirement

In the Action mailed on May 19, 2005, the Examiner restricted the application to the following Groups of claims:

I: Claims 1-6, 21, and 22, drawn to a system for draining fluid from a layered soil profile;
and

II: Claims 12-20, drawn to a method of draining fluid from a layered soil profile.

Election and Traverse

Applicant elects Group I, i.e., claims 1-6, 21 and 22. This election is made *with traverse*.

The Office carefully makes the case that the claims of Groups I and II are *distinct*:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (citation omitted). In the instant case, the system for draining fluid from a layered soil profile, as claimed, can be used in a materially different process of using that product such as a process which does not include the step of separating the layers of the soil profile. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

(Office Action, page 2). Thus, based on these assertions the Office concludes by stating that because distinctiveness has been shown, restriction is proper. However, Applicant submits that restriction is not proper in this instance. M.P.E.P. § 803 states the requirement for a *proper* restriction.

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; **and (B) There must be a serious burden on the examiner if restriction is required.**

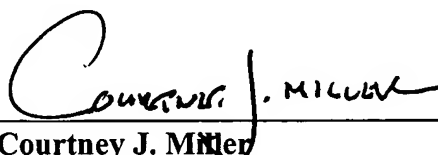
(M.P.E.P. § 803, citations omitted, emphasis added.) Thus, there are *two* requirements for restriction: distinctness *and* a serious burden on the Examiner. Both are required; distinctness without a serious burden is not sufficient to justify restriction. Indeed, section 803 explicitly states that “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”

Applicant respectfully submits that restriction is not proper in this case. While the claims of Groups I and II may satisfy the Office's requirements for distinctness, their joint consideration would hardly result in a serious burden on the Examiner. The technology underlying both sets of claims is related, and thus a thorough prior art search conducted for one set of claims would certainly yield results useful for examination of the other set of claims. Thus, as stated, the Applicant asserts that restriction is improper.

If issues relating to this application can be resolved by discussion, the Examiner is invited to contact the undersigned attorney by telephone.

Respectfully submitted,

Date: July 19, 2005

A handwritten signature in black ink, appearing to read "Courtney J. Miller", is written over a horizontal line.

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